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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,262	12/12/2003	Kazuto Shimada	003510-147	8665
21839	7590	02/01/2005	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			GILLIAM, BARBARA LEE	
POST OFFICE BOX 1404			ART UNIT	
ALEXANDRIA, VA 22313-1404			PAPER NUMBER	
			1752	
DATE MAILED: 02/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,262

Applicant(s)

SHIMADA ET AL.

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed 10/27/2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-9 and 11-16 is/are allowed.
- 6) ☒ Claim(s) 2 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/793,760.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed October 27, 2004 has been entered and fully considered.
2. Claims 1-16 are present.
3. The 112, 1st paragraph rejection of claims 1-8 is withdrawn in light of the amendment and Applicant's Remarks.
4. The indicated allowability of claim 10 is withdrawn.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for drying the photosensitive layer coating at a drying temperature not less than 150°C and not greater than 200°C and for a drying time of 20 to 110 seconds, does not reasonably provide enablement for further drying the photosensitive layer coating solution at a drying temperature of less than 150°C. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for drying the photosensitive coating layer under reduced pressure at 300 mmHg or less, does not reasonably provide enablement for a additional step of drying the photosensitive coating layer at a normal pressure. The

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specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

According to the specification the drying step can be conducted twice or more under moderate conditions or a method of drying under reduced pressure at 300 mmHg or less can be used (page 53, lines 23-25; Examples 14-29). There is no support for an additional heating step at a temperature specifically less than 150°C as required in claim 2 after being dried at not less than 150°C and not greater than 200°C and for 20 to 110 seconds. Nor is there support for claim 10 wherein the photosensitive layer coating solution is dried at normal pressure after being dried under a reduced pressure of 300 mmHg or less.

Allowable Subject Matter

7. Claims 1, 3-9, 11-16 are allowed.
8. The following is a statement of reasons for the indication of allowable subject matter:

- a. In Nakamura et al. (US 6,132,929), a positive type photosensitive composition is used to make a directly producible printing plate wherein the composition is dissolved in a solvent, which can be used alone or in combination, and applied to substrate (column 43, lines 33-60). The disclosure of Nakamura et al. fails to teach the conditions under which the coated photosensitive composition is dried (see Examples I-1, I-2, II-1, II-2). There is nothing in the prior art that would lead one of ordinary skill in the art to the specific drying conditions required in the present claims.

Response to Arguments

9. Applicant's arguments, see page 10, 4th paragraph – page 11, filed October 27, 2004, with respect to the rejection of claims 1-8 under 35 USC 112, 1st paragraph have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is deemed appropriate.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Barbara L. Gilliam

Barbara L. Gilliam
Primary Examiner
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bg
January 28, 2005